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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,521	04/02/2001	Ian Catley	112740-188	9765

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EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,521

Applicant(s)

CATLEY ET AL.

Examiner

Simon Sing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicants claim a limitation of subscriber lines in claims 1-10. However, in the specification and the drawing, the telephone lines, described by the applicants as subscriber lines, are actually PBX extension lines.

2. Claims 6, 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control*

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Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "a further first subscriber line" is used by the claims to mean "a third subscriber line". The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Erb US 6,130,938.

3.1 Regarding claim 1, Erb discloses method of automatic call forwarding in figure1.

Erb teaches:

changing a forwarding [destination] number (column 2, lines 32-41);

storing the forwarding number in a table [memory] (column 2, lines 55-62);

checking with a controller with a second telephone line to see if a call forwarding is successful, and if not a next forwarding telephone number is tried (column 3, lines 31-36).

3.2 Regarding claim 3, it is inherent that a user may forward a call intended for a first telephone number to a second telephone number and vice versa.

3.3 Regarding claim 5, Erb teaches forwarding an incoming call to a group of telephone numbers (column 3, lines 66-67; column 4, lines 1-10).

3.4 Regarding claim 6, Erb teaches forwarding an incoming call to a third telephone number if a second telephone number is not available (column 3, lines 31-36), and a user may update a call forwarding telephone number (column 2, lines 32-41). It is inherent that a user may activate or deactivate the automatic call forwarding service.

3.5 Regarding claim 7, it is inherent that another user with one of the call forwarding telephone numbers may also forwarding his call to the same forwarding telephone numbers.

4. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Harlow et al. US 5,206,901.

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4.1 Regarding claim 1, Harlow discloses a method for alerting multiple telephones for an incoming call in figures 1-3. Harlow teaches storing multiple telephone numbers associated with a primary directory number in a shared database [memory] (column 2, lines 25-41; column 4, lines 35-54), and when a call directed to the primary directory number comes, the call is forwarded to the multiple telephone numbers stored in the shared database (column 2, lines 32-53; column 4, lines 55-68; column 5, lines 1-10). Harlow teaches checking with other service switch point [control unit] associated with the multiple telephone numbers to setup the call (column 4, lines 55-68; column 5, lines 1-10).

4.2 Regarding claim 2, Harlow teaches that a shared database 175, containing a telephone number associated with a second line (Figure 1; column 4, lines 47-54).

4.3 Regarding claim 9, Harlow teaches forwarding an incoming call, intended for a primary telephone number, to an alternate telephone number and applying ringing signals to both telephones (column 5, lines 1-10).

4.4 Regarding claim 10, Harlow teaches alerting multiple alternate telephone number associated with a primary number (column 5, lines 1-10). It is inherent that when a user moves from one location to another (such as from office to home), a primary [home telephone] will become an alternate, and an alternate [office telephone] will become a primary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harlow et al. US 5, 206,901 in view of Plomondon et al. US 5,729,599.

Harlow teaches directing an incoming call to a plurality of alternate telephone numbers (column 4, lines 35-68; column 5, lines 1-10), and storing the alternate telephone numbers in a shared database 175 (Figure 1; column 4, lines 47-54).

Harlow fails to teach checking whether the alternate numbers are valid or not.

However, Plomondon discloses a method for forwarding telephone calls in figures 1- 3. Plomondon teaches checking the availability of forwarding destinations (column 7, lines 18-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Harlow's reference with the teaching of Plomondon, so that the alternate number would have been verified before being stored in the database, because such a modification would have avoided forwarding a call to a non exist telephone number.

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harlow et al. US 5, 206,901 in view of Davidson et al. US 4,873,717.

Harlow teaches directing an incoming call to a plurality of alternate telephone numbers (column 4, lines 35-68; column 5, lines 1-10), but fails to teach displaying call forwarding information.

However, Davidson teaches a call coverage arrangement. Davison teaches that when a primary telephone number receives a call, the call is forwarded to a second telephone number and the call forwarding information is displayed on a telephone set associated with the second telephone number (column9, lines 33-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Harlow's reference with the teaching of Davidson, so that the call forwarding information would have been displayed on a telephone set associated with a alternate telephone number, because such a modification would have enabled a user associated with the alternate telephone to identify a forwarding call from a regular incoming call.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



S.S.

07/16/2003